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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,882	12/29/2003	Josef Heftberger	7590-X03-004	2787
27317	7590	09/13/2005	EXAMINER	
FLEIT KAIN GIBBONS GUTMAN BONGINI & BLANCO 21355 EAST DIXIE HIGHWAY SUITE 115 MIAMI, FL 33180				BOTTORFF, CHRISTOPHER
		ART UNIT		PAPER NUMBER
		3618		

DATE MAILED: 09/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/747,882	HEFTBERGER ET AL.
	Examiner Christopher Bottorff	Art Unit 3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 June 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 December 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/25/04</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of invention I, a core for sliding bodies directed toward claims 1 and 2, in the reply filed on June 17, 2005 is acknowledged. The traversal is on the grounds that search and examination can be made without a serious burden since the search of both inventions would overlap. This is not found persuasive because searching in the same area does not determine if a search is burdensome when two distinct inventions are involved. The apparatus of invention I and the method of invention II each require an individual and unique focus during searching. A search of the apparatus requires a focus on physical structure while a search of the method requires a focus on acts and procedures. The separate focus required for each search creates a serious burden. Moreover, the method involves additional features that are not found in the apparatus and involves a search that goes beyond class 280, unlike the apparatus.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 17, 2005.

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Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Austria on July 10, 2001. It is noted, however, that a certified copy of the Austrian application has not been filed as required by 35 U.S.C. 119(b).

Information Disclosure Statement

The information disclosure statement (IDS) submitted on June 25, 2004 was considered by the examiner.

Also, the listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references cited in the specification have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Terminology used in claim 1 is not clear and distinct. The limitation in lines 1 and 2 reciting "e.g., skis, in particular cross-country skis," does not clearly state whether or not the claim is limited to skis generally or cross-country skis specifically, or if skis are merely provided as objects of the intended use of the core. The use of the term "ski" on line 3 suggests that the invention is limited to skis generally, but this is not clear. For the purposes of examination, this limitation is interpreted as limiting the invention to skis generally.

Also, the limitation on line 5 reciting "preferably in the binding region" does not clearly state whether or not the grooves or slits must be in the binding region or their placement in the binding region is merely optional. For the purposes of examination, this limitation is interpreted such that the grooves or slits do not have to be in the binding region.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber US 3,369,821 in view of McCaskey, Jr. et al. US 4,077,652.

Weber discloses a light weight construction ski core having at least three grooves, respectively, arranged in longitudinal rows such that the grooves extend in the

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longitudinal direction of a ski. See Figures 10 and 5. Since each longitudinal row is separated from the neighboring rows by a distance, the grooves are offset row-wise relative to each other. The grooves, respectively, are formed to be open towards the running surface only and have a circular-arc-shape. See Figure 10. Although the shape of the grooves is viewed Figure 10 in the cross section and not the longitudinal section, the circular-arc-shape would still exist when the core is viewed in the longitudinal section but would not be viewed as clearly.

Weber discloses that the core is made of plastic rather than wood. However, McCaskey, Jr. et al. teach that wood is also a desirable material in making a ski core. See column 2, lines 22-26. From the teachings of McCaskey Jr. et al., making the core of Weber from wood rather than plastic would have been obvious to one of ordinary skill in the art at the time the invention was made. This would provide the core with a suitable material even for high performance skiing.

Allowable Subject Matter

Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The requirement that neighboring grooves must be offset relative to each other by half the groove length is not suggested by the prior art.

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Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jost et al., Plenk, Staufer, You, Scherübl, Pelizzari, Rouser et al., Rohrmoser, Kraft et al., Olson, Fischer, Piatti, and Franklin disclose ski constructions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (571) 272-6692. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Ellis can be reached on (571) 272-6914. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Bottorff